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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,199	01/31/2005	Helen Ambrosen	C89.12-0001	3574

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WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402

EXAMINER	
BOYER, CHARLES I	

ART UNIT	PAPER NUMBER
1796	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/501,199	AMBROSEN ET AL.	
	Examiner	Art Unit	
	Charles I. Boyer	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-27 and 29-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/4/07, 4/16/07, 7/09/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 36 is objected to because of the following informalities: In line 2 of claim 36, it appears the word "shampoo" is missing. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Before citing the references against the present claims, the examiner would like to state for the record that due to the inordinate breadth of the present claims, requiring only a composition containing cocoa butter, the examiner maintains that a thorough search is impossible. Cocoa butter is a primary ingredient in chocolate bars and other confections, as well as an extremely common ingredient in lip balms, lip sticks, suppositories, and deodorant sticks. Though a few of these references are cited below, the examiner estimates there are hundreds of references that would anticipate at least

claim 24 of the present application. Any response from applicants to the references cited below that does not also address the fact that their claims are extremely broadly written, together with a clear statement of what applicants consider to be the novelty of their invention, will likely not be successful in rendering these claims allowable.

2. Claims 24, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Staniforth et al, US 2003/0138503.

Staniforth et al teach topical formulations comprising vegetable oils and 50%, 40%, and 30% cocoa butter, wherein the oils and cocoa butter are melted with heating and cooled to form a solid product (¶178-191). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

3. Claims 24, and 30-32 are rejected under 35 U.S.C. 102(a) as being anticipated by Girsh, US 2001/0007690.

Girsh teaches a chocolate bar comprising 26.5% cocoa butter and lecithin, wherein the ingredients are heated with mixing and are allowed to cool to form chocolate squares (¶147). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

4. Claims 24, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al, US 4,360,387.

Brown et al teach a sun protection stick comprising 10% cocoa butter and 6% olive oil (col. 5, example 4). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

5. Claims 24, and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott, US 3,932,614.

Scott teaches a lipstick comprising 16% cocoa butter and lanolin (¶147). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

6. Claims 24, 29, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Ambrosen et al, US 2003/0157050.

Ambrosen et al teach a lotion bar comprising 16% cocoa butter and 10.5% almond oil (¶14). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

7. Claims 24, 27, and 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by McGinity et al, US 5,622,993.

McGinity et al teach a stick formulation comprising 11.8% cocoa butter, 8.3% cetyl alcohol, castor oil, and surfactant (col. 5, lines 46-59). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 24, and 31-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlaeger, US 6,241,978.

Schlaeger teaches a solid hair conditioner comprising from 30 to 60% of a solid continuous phase, and from 15 to 35% of a liquid oil phase (col. 5, lines 5-28), wherein the final product contains 8% cocoa butter, 2% silicone surfactant, rapeseed oil, and other emollients (col. 18, example 2), and wherein the conditioner is in stick form and is prepared by melting the ingredients, then cooling and solidifying the mixture (col. 18, lines 21-35). Liquid oils, such as cocoa butter are present in an amount from 15 to 35% (col. 21, claim 2). Accordingly, it would have been obvious to one of ordinary skill in the art to use slightly more cocoa butter in example 2 above with complete confidence of successfully obtaining an effective hair conditioner.

With respect to present claims requiring a shampoo, the examiner notes this is an extremely broad term and any composition for contact with the hair or skin that contains a cleaning agent, such as a surfactant, may be considered to be a shampoo. As the solid phase above contains a surfactant which is mixed with liquid emollients, i.e. conditioners, the examiner maintains these claim limitations are satisfied. Note that colorants are highly preferred ingredients in these hair treatment compositions (col. 13,

lines 1-29). Though it appears that the colors in these hair treatment compositions are homogeneous, it is certainly within the skill level of persons in the art to formulate multicolored solids, if not for practical reasons, then merely for reasons of aesthetics.

With respect to the method of fabricating a solid, it is well known that solids are prepared by heating with mixing, and then allowing the mixtures to cool. Note that the solid phase and liquid phases are mixed separately at different temperatures, and are then added to a common mixer which is set at a different temperature (col. 18, lines 21-35). Although the reference does not specifiy a temperature range wherein mixing occurs, the examiner considers mixing at any point during the heating or cooling process of forming a solid to be an obvious preparation step to the skilled formulator.

10. Claims 33-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi, US 4,017,574.

Joshi teaches a multi-colored soap bar comprising 3% of a colored material consisting of cocoa butter and a base soap material (col. 6, example 5). The examiner acknowledges that claim 33 depends from claim 24, which is not rejected by the reference, but maintains that claim 33 changes the solid form of claim 24 to a molten form which is mixed with the shampoo, thereby forming an entirely separate composition from the solid of claim 24 and so claim 33 is in effect an independent claim. To support this assertion, note that claim 37 requires that the solid conditioner and shampoo form a pattern, and claim 39 requires the pattern to be a spiral pattern. The examiner considers such a configuration to be nearly impossible without melting and

mixing the solid hair conditioner and the shampoo to form the spiral. This is now merely a solid that contains cocoa butter, which is satisfied by the soap bar of the reference.

With respect to present claims requiring a shampoo, the examiner notes this is an extremely broad term and any composition for contact with the hair or skin that contains a cleaning agent, such as a surfactant, may be considered to be a shampoo. As the solid phase above contains a surfactant, i.e. soap, which is mixed with cocoa butter conditioner, the examiner maintains these claim limitations are satisfied. Note that the cocoa butter and soap are different colors and form striations in the finished soap bar (col. 6, lines 23-43). Given this, it is well within the skill level of persons in the art to formulate these striations in a spiral pattern.

With respect to the method of fabricating a solid, it is well known that solids are prepared by heating with mixing, and then allowing the mixtures to cool. Note that the liquid colored material, i.e. cocoa butter, is maintained in a molten state and is then added to the soap (col. 4, lines 43-55). Although the reference does not specifiy a temperature range wherein mixing occurs, the examiner considers mixing at any point during the heating or cooling process of forming a solid to be an obvious preparation step to the skilled formulator.

11. Claims 24-27, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staniforth et al, US 2003/0138503.

12. Staniforth et al are relied upon as set forth above. Suitable hardeners and plasticizers of the invention include cetyl alcohol, stearyl alcohol, stearic acid, and

propylene glycol (¶147). Accordingly, it would have been obvious to one of ordinary skill in the art to incorporate any of these hardeners or plasticizers in the solids of the reference with a reasonable expectation of successfully obtaining an effective topical formulation.

13. Claims 24, 29, 31-36, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harbeck, US 2001/0014315.

Ambrosen et al teach a bar soap comprising from 100 to 5000g soap base, up to 200g cocoa butter, and additional vegetable oils (¶67-74). As the proportions of the reference overlap those presently claimed, it would have been obvious to one of ordinary skill in the art to prepare a bar soap comprising 10% cocoa butter with a reasonable expectation of successfully obtaining an effective bar soap.

With respect to present claims requiring a shampoo, the examiner notes this is an extremely broad term and any composition for contact with the hair or skin that contains a cleaning agent, such as a surfactant, may be considered to be a shampoo. As the solid phase above contains a surfactant, i.e. soap, which is mixed with cocoa butter conditioner, the examiner maintains these claim limitations are satisfied.

With respect to the method of fabricating a solid, it is well known that solids are prepared by heating with mixing, and then allowing the mixtures to cool. Note that the soap mixture is heated, allowed to cool to 35°C, then additional ingredients are added, and the mixture is stirred until it cools (¶77-85). Although the reference does not specifiy a temperature range wherein mixing occurs, as the mixture is stirred until it

cools, the examiner maintains this overlaps the temperature range claimed, and considers mixing at any point during the heating or cooling process of forming a solid to be an obvious preparation step to the skilled formulator.

Allowable Subject Matter

14. Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles I. Boyer whose telephone number is 571 272 1311. The examiner can normally be reached on M-Th 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272 1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charles I Boyer
Primary Examiner
Art Unit 1796

/Charles I Boyer/
Primary Examiner, Art Unit 1796